



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/584,071

06/22/2006

Shigenori Tanaka

Q95625

4850

23373 7590 09/08/2009
SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
SUITE 800
WASHINGTON, DC 20037

EXAMINER

SRIVASTAVA, KAILASH C

ART UNIT

PAPER NUMBER

1657

MAIL DATE

DELIVERY MODE

09/08/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/584,071	Applicant(s) TANAKA ET AL.	
	Examiner Kailash C. Srivastava	Art Unit 1657	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 August 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 6-10 and 14-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-5 and 11-13 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Response and amendments filed 04 August 2009 in response to Office Action mailed 14 April 2009 is acknowledged and entered.

Claims Status

2. Claims 1-23 are pending.
3. Claims 1-2, 4, 8, 10-11, 13, 16-17, 19 and 22 have been amended.

Election /Restriction

4. Election without traverse of Group I encompassing Claims 1-5 and 11-13 in the response filed 04 August 2009 is acknowledged and entered. Since the election is made without traverse, the restriction requirement is deemed proper and is made FINAL.

Accordingly, Claims 6-10 and 14-23 are withdrawn from further consideration as being directed to a non-elected invention. See 37 CFR §1.142(b) and MPEP §821.03.

5. Upon further consideration, Restriction of elected Claims 1-5 and 11-13 to one of the following inventions is required under 35 U.S.C. 121:

- Group A, consisting of claims 1-3 drawn to a method to measure lipoarabinomannan in a lipoarabinomannan –containing sample.
- Group B, consisting of claims 4-5 drawn to a method to detect an acid-fast bacterium, wherein the acid-fast bacterium is a tubercle bacillus.
- Group C, consisting of claims 11-15 drawn to a method to measure an endotoxin using a Limulus reagent in a lipoarabinan-containing sample, wherein the Limulus reagent is an endotoxin-specific Limulus reagent.
- Group D, consisting of Claim 13 drawn to a method to detect an endotoxin-related disease.

Inventions are Independent and Distinct

6. The inventions listed in Groups A-D above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The patent rules under 37 C.F.R §1.475 for Unity of Invention (Paragraphs (a), (b) and (c)) are cited below:

§1.475 Unity of Invention before the International Searching Authority, the International Preliminary Examining Authority and during the National Stage

(a) An International and National Stage Application shall relate to one invention only, or to a group of inventions so linked as to form a general inventive concept (“requirement of unity of invention”). Where a group of inventions is claimed in an application, the requirement of unity of invention shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression “special technical features” shall mean those technical features that define a contribution which each of the claimed inventions, considered as whole, makes over the prior art.

(b) An International or a National stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:

- (i) A product and a process specially adapted for the manufacture of said product; or
- (ii) A product and process of use of said product; or
- (iii) A product, a process specially adapted for the manufacture of the said product, and a use of the said product; or
- (iv) the said process; or
- (v) A product, a process specially adapted for the manufacture of the said product, and an apparatus or means specifically designed for carrying out the said process.

(c) If an application contains claims to more or less than one of the combinations of categories of invention set forth in paragraph (b) of this section, unity of invention might not be present. The groups of invention fall within category [(2), a product and a method of use of said product].

7. The inventions listed as Groups A-D do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

PCT Rule 13.2 does not provide for multiple compositions, or multiple methods of making a composition, or multiple methods of use of a composition within a single application. Thus, the first appearing composition is combined with a corresponding first method of making said composition (if applicable) and/ or use of said composition. However, the additional composition and method claims each constitute a separate inventive Group.

The special technical features of each of groups A-D inventions are different to each other because they each lead to a different effect through different steps. Furthermore, inventions in each of the

Groups A-D, as pointed at Page 4, Lines 14-22 of the Office Action mailed 14 April 2009 are notoriously well known in the art (see for e.g., U.S. Patent 5, 565,233 (e.g., Column 21, Line 62-Column 22, Line 41; Column 30, Line 55-Column 31, Line 22)). Since no special technical feature exists between the inventions of groups A-D, there is no unity of invention.

The expression, "special Technical Feature" refers to those features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art. Thus, a feature found in the prior art can not be considered to be a special technical feature.

8. In accordance with 37 C.F.R §1.499, applicant (S) is/are required, in response to this action, to elect a single invention to which the claims must be restricted.

Applicants is/are advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement is traversed (37 C.F.R §1.143).

9. Applicant (S) is/are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R §1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 C.F.R §1.48(b) and by the fee required under 37 C.F.R §1.17(i).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Kailash C. Srivastava whose telephone number is (571) 272-0923. The examiner can normally be reached on Monday to Thursday from 7:30 A.M. to 6:00 P.M. (Eastern Standard or Daylight Savings Time).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jon Weber can be reached at (571)-272-0925 Monday through Thursday 7:30 A.M. to 6:00 P.M. The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding may be obtained from the Patent Application Information Retrieval (i.e., PAIR) system. Status information for the published applications may be obtained from either Private PAIR or Public PAIR. Status information for

unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (i.e., EBC) at: (866)-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kailash C Srivastava/
Patent Examiner
Art Unit 1657
(571) 272-0923

07 September 2009

/JON P WEBER/
Supervisory Patent Examiner, Art Unit 1657